

REMARKS

Claim 2 has been canceled. Claims 1, 3, 4, 5, 27, and 55 have been amended. Therefore, claims 1, 3-6, 9-13, 22, 24-36, 38-43, and 54-71 remain pending. Applicants reserve the right to pursue the original claims in this and other applications. Reconsideration and withdrawal of all outstanding rejections are respectfully requested in light of the foregoing amendments and the following remarks.

Claim 27 stands rejected under 35 U.S.C. § 112, second paragraph, for reciting the phrase “said second processor system.” Claim 27 has been amended to obviate this rejection and withdrawal of the rejection is respectfully requested.

Claims 1, 7, 9-13, and 54-60 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,249,690 to Mashiko (“Mashiko”). The rejection is traversed and reconsideration requested.

Independent claim 1 relates to a portable wireless memory module for storing data. One feature of the claimed memory module is “a transmitter/receiver circuit” for wireless transmission and reception “using radio waves.” As acknowledged by the Office Action, Mashiko provides no teaching or suggestion relating to wireless transmission for a memory module utilizing radio waves. Office Action, at 5. Similarly, independent claim 55 relates to a system comprising a portable memory module having a “a transmitter/receiver” for wireless transmission and reception “using radio waves.” Claims 7, 9-13, and 54 each depend from claim 1 and contain all of the limitations recited by claim 1. Claims 56-60 each depend from claim 55 and contain all of the limitations recited by claim 55. For at least these reasons, withdrawal of the rejection of claims 1, 7, 9-13, and 54-60 is respectfully requested.

Claims 2-6, 7, 10, 11, 22, 24-28, 35-36, 38-43, 67-71 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Mashiko and U.S. Patent Pub. No. 2001/0049262 to Lehtonen (“Lehtonen”). The rejection is traversed and reconsideration requested.

Applicant does not agree that it would have been obvious to combine the teachings of a hands-free function for a cellular phone in Lehtonen with the teachings of a portable battery charger as taught by Mashiko. Not only are the teachings directed to unrelated art, but also, to combine these teachings as suggested in the Office Action would require a modification of one or both of the references that would “change the principle of operation of the prior art invention being modified.” M.P.E.P. §2143.01 (citing *In Re Rattio*, 270 F.2d 810 (CCPA 1959)). Only by application of impermissible hindsight, when considering the teachings in the present application, would one of skill in the art be motivated to combine the portions of Lehtonen with portions of Mashkio as done in the Office Action to arrive at the claimed invention.

In addition, even if there was some motivation or suggestion to combine the reference teachings, of which there is none, the combination does not teach all of the claim limitations recited in the rejected claims. Specifically, independent claims 22, 36, and 67 relate to an apparatus and method involving the wireless transmission of data, that is received by a portable memory module from “a first processing system,” from said portable memory module to “any of a plurality of [other] processor systems.” Neither of the cited references, whether considered alone or in combination, teaches or suggests this limitation. The Office Action acknowledges that Applicant’s previous argument on this point with respect to Lehtonen is persuasive. Office Action, at 21. Moreover, Mashiko does not cure this deficiency. In fact, in the passage of Mashiko cited by the Examiner, Mashiko teaches the transmission of a first data between a first processing system and a first battery charger and a transmission of a second, different data between a second processing system and the battery charger. See, Figs. 3-5 and accompanying text, including col. 13, lines 12-42 and col. 10, lines 15-42. Mashiko provides no teaching of wireless transmission of data between a first processor system and a portable memory module and wireless transmission of the data to a second processor system.

For at least these reasons, withdrawal of the rejection of claims 2-6, 7, 10, 11, 22, 24-28, 35-36, 38-43, 67-71 is respectfully requested.

Claims 1-6, 9, 12, 13 and 54 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lehtonen. The rejection is traversed and reconsideration requested. Specifically, the Office Action states that Applicant’s previous remarks, presented August 3, 2005, were

persuasive for overcoming the previous rejection. Office Action, at 21. The current rejection was previously applied and should be withdrawn for at least the reasons presented in Applicant's previous response and for the reasons presented herein.

Claims 29-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lehtonen and Mashiko, and further in view of U.S. Patent Pub. No. 2002/0078248 to Janik et al. ("Janik"). The rejection is traversed and reconsideration requested. Specifically, claims 29-34 each depend from claim 22 and contain all of the limitations recited therein. For whatever Janik teaches regarding a self-contained power supply, such as a rechargeable battery, Janik does not cure the deficiencies of Lehtonen and Mashiko as discussed herein. Janik neither teaches nor suggests the unique limitations of claim 22, recited above, nor does Janik provide an objection suggestion or motivation to combine the teachings of Lehtonen, Mashiko, and Janik as suggested in the Office Action. For at least these reasons, reconsideration and withdrawal of the rejection are requested.

Claims 61-66 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,622,031 to McCleary ("McCleary"). The rejection is traversed and reconsideration requested.

The present invention relates to a portable memory module. More specifically, claims 61-66 relate to a "portable wireless computer storage device comprising," *inter alia*, "a controller in communication with said transmitter/receiver circuit and said at least one memory device for storing in said memory device data received from a general purpose computer in response to a data storage command and for retrieving stored data from said memory device for transmission to a general purpose computer in response to a data retrieval request from a general purpose computer."

Unlike the claimed invention, McCleary relates to an antenna for a handheld device, such as a PDA. McCleary is not a "portable wireless computer storage device." For whatever McCleary teaches regarding transmission of data, McCleary does not teach a controller as described in claims 61 that "[stores] data received from a general purpose computer in response to a data storage command and for retrieving stored data from said memory device for transmission to a general purpose computer in response to a data retrieval request from a general

purpose computer.” Rather, the handheld device 100 of McCleary has a processor 101 for generating data storage commands. Data is stored in the device 100 in response to data from the processor 101, not in response to a data storage command received from an external general processing system.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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